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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,446	11/10/2003	Raymond F. Horvath	UDL-004D2 (9424/6)	4873
48425	7590	07/29/2005	EXAMINER	
LAWSON & WEITZEN, LLP 88 BLACK FALCON AVE SUITE 345 BOSTON, MA 02210			HABTE, KAHSAY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/705,446

**Applicant(s)**

HORVATH ET AL.

**Examiner**

Kahsay Habte, Ph. D.

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 76 is/are pending in the application.
- 4a) Of the above claim(s) 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/9/04&amp;11/10/03</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1 and 76 are pending in this application.

***Election/Restriction***

2. Applicant's election with traverse of Group VII (Pyridines fused to a 5-membered N-containing ring), Claim 1 in a paper filed 3/16/2005 is acknowledged. The traversal is on the ground that "a search for prior art relating to any of the compounds having a core formula with substituents in groups I through XIV of the claims would necessarily reveal others". The examiner disagrees with applicants. Coexamination of each of the additional groups would require search of subclasses unnecessary for the examination of the elected claims. For example, the search for the invention of Group I would include search of subclass 544/180 and 544/184, the search for the invention of Group II would include search of subclass 544/250, 544/251 and 544/346, the search for the invention of Group III would include search of subclass 546/87, the search for the invention of Group V would include search of subclass 544/278 and 544/180, and the search for the invention of Group VI would include search of subclass 544/293. Therefore, coexamination of each of these additional inventions and the search of class and subclass of Groups VIII-XIV would require a serious additional burden of search.

The requirement is still deemed proper and is therefore made FINAL.

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3. Claim 1 is drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action. It is required that applicants delete core structures i.e. Formula I, VI, X, XII, XIII, XIV and XV that are not drawn to the elected invention of Group VII (Pyridines fused to a 5-membered N-containing ring (bicyclic)) and also delete variables and their definitions that don't belong to the elected invention.

#### ***Abstract***

4. The abstract of the disclosure is objected to because it is more than one page.

#### ***Information Disclosure Statement***

5. Applicant's Information Disclosure Statement, filed on 07/09/2004 and 11/10/2003 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

#### ***Claim Objections***

6. Claim 1 is objected to because of the following informalities: In claim 1 (page 9), the definition for  $R^{12}$  contains a typographical error. " $R^{12}$  is.... $NR^8R^9$ ," should read as " $R^{12}$  is.... $NR^8R^9$ ".

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. In claim 1, the phrases “aminocarbocycle” and “aminoheterocycle” are not clear. Carbocycle is impossible, because N is present in the ring. The presence of nitrogen in a ring will make a heterocycle not a carbocycle.

b. In claim 1, the phrase “A and R<sup>2</sup> jointly...optionally substituted at each position with R<sup>7</sup>” is incorrect. The substitution can only be at the carbons not at each position i.e. oxygen or sulfur can only make two bonds and the substitution of R<sup>7</sup> is not allowed.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624

KH  
July 26, 2005